

### REMARKS

Claims 1-2, 4, 5, 7, 9, -11, 19-25, and 27 are in this application. Claims 3, 6, 8, 12-18 and 26 have been cancelled. Claims 1 and 5 have been amended.

According to the Examiner, Claims 19-20 are rejected under 35 USC 112, first paragraph as failing to comply with the enablement requirement. This is respectfully traversed.

Claims 19 and 20 are methods of inhibiting TGF  $\beta$ 1 and AngII receptor converting enzyme, respectively.

Examples 1 and 2 shows the effect on inhibition of TGF  $\beta$ 1. Tables 5B and 5D shows the change of serum TGF  $\beta$ 1 and Angiotensin II in rats.

According to MPEP 2164.08(b):

The presence of inoperative embodiments within the scope of a claim does not necessarily render a claim nonenabled. The standard is whether a skilled person could determine which embodiments that were conceived, but not yet made, would be inoperative or operative with expenditure of no more effort than is normally required in the art. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1577, 224 USPQ 409, 414 (Fed. Cir. 1984) (prophetic examples do not make the disclosure nonenabling).

Furthermore according to MPEP 2164.01:

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute

does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.").

The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), *aff'd. sub nom.*, *Massachusetts Institute of Technology v. A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985). See also *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404. The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976).

Therefore, based the disclosure in the application, it is clear that claims 19 and 20 are enabled.

It is respectfully requested that this rejection be withdrawn.

According to the Examiner Claims 1-3, 10-11 and 27 are rejected as being anticipated by El-Kerdawy. According to the Examiner Claims 1, 4, 10-11 and 27 are rejected as being anticipated by Levy et al.; Claims 1-2 and 4 as being anticipated by Bylov; Claims 1-2, 4, 10-11 and 27 as anticipated Ogiso; and Claims 1-2, 4, 10-11 and 27 as anticipated by Reusser. According to the Examiner Claims 1-3, 10-11 and 27 are rejected as being obvious over El-Kerdawy; Claims 1-4, 10-11 and 27 over Ukhov; and Claims 1-4 over Bylov.

These rejections are respectfully traversed.

Claim 1 has been amended to exclude hydrogen from the definition of R<sup>7</sup>. Therefore, the claims are not anticipated by the cited references.

In regard to the obviousness rejections, there is no teaching, suggestion or motivation that there must always be a substituent at C7.

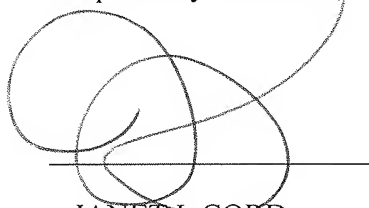
It is respectfully requested that the rejections under 35 USC 103 be withdrawn.

The Examiner rejected claims 1-2, 4-5, 7, 9-11, 19-25 and 27 under 35 USC 112, second paragraph. This is respectfully traversed.

In view of the amendment to claim 1 this rejection is moot and it is respectfully requested that the rejection be withdrawn.

It is submitted that the present application is in condition for allowance.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'JANET I. CORD', is written over a horizontal line. The signature is stylized with large, overlapping loops.

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